1639

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Joseph Fisher *et al.* Serial No.: 09/293,670 Filed: April 16, 1999 For: *Multiparameter Facs Assays To Detect Alterations In Cellular Parameters And To Screen Small Molecule Libraries*	Examiner: Wessendorf, Teresa D. Group Art Unit: 1639 Docket No.: **RGS-006.02 (25990-602)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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By: _____
Shirine Darvish

RESPONSE TO RESTRICTION REQUIREMENT

Dear Examiner Wessendorf:

This is in response to the Restriction Requirement dated March 15, 2005 in the above-referenced application.

The Examiner has required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: Claims 17-32, drawn to a method of screening for an alteration in cellular phenotype comprising a population of retrovirally infectable cells comprising a library of retroviral vectors encoding different candidate bioactive agents.

Group II: Claims 33-36, drawn to a method of screening for an alteration in cellular phenotype comprising combining a population of cells with a candidate bioactive agent.

It is the position of the Examiner that Groups I and II are unrelated because the inventions are allegedly drawn to different methods using different components and steps that produce different results/compounds with different effects and/or functions.

Applicants provisionally elect ***Group I, with traverse***, for prosecution on the merits. In addition, with respect to the unelected group, Applicants traverse the restriction requirement to the extent that the method of Group II (claims 33-36) is related to that of Group I (claims 17-32), since the method claims in Group II may be practiced using certain of the species that are defined in the method claims of Group I. Thus, the methods are not disclosed as having different effects or modes of operation. Further, Applicants respectfully assert that simultaneous examination of Groups I and II would not place an undue burden on the Examiner because the claims of the two Groups in certain embodiments would involve certain similar steps. Thus, a search for Group I would necessarily entail searching for a substantial portion of Group II as well. *See* MPEP § 803 ("If the search and examination of an entire application can be made without serious burden, the [E]xaminer must examine it on the merits, even though it includes claims to independent or distinct inventions."). Accordingly, Applicants further traverse the restriction requirement to the extent that Groups I and II should be reformed as a single group comprising claims 17-36.

In addition to restriction between sets of claims, the Examiner further requires election of a species from among several allegedly distinct sorting means recited in claim 26 (subgroup A), from among several allegedly distinct bioactive agents as recited in claims 30-32 (subgroup B) and from among several allegedly distinct positive controls as recited in claim 32 (subgroup C).

Applicants provisionally elect the species *annexin granule* binding from subgroup A, the species *peptide, with traverse* from subgroup B, and the species *p21, with traverse* from subgroup C. Applicants' grounds for traversal are set forth below.

It is Applicants' position that while a species election may be proper in each case among the species of each Subgroup for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, an election under 35 U.S.C. §121 is improper if the claims reciting the various species are linked by an allowable generic linking claim (see M.P.E.P. §809.02). For example, claim 17 requires that the method comprise *sorting said population of cells based on at least five parameters* using fluorescence activated cell sorting

(FACS), the species of which genus are recited in dependent claim 26. Further, claim 17 requires that the method comprise a population of retrovirally infectable cells comprising a *library of retroviral vectors encoding different candidate bioactive agents*, wherein the various species of bioactive agents are recited in dependent claims 30-32. Finally, claim 32 provides that the method of claim 17 additionally comprise a positive control, which may be selected from the recited species. At the very most, applicants should be restricted to a single species for search purposes only. It is Applicants' understanding that the search will be extended to the remaining species of each Subgroup upon a finding of allowability, and that the non-elected species of each Subgroup will be rejoined upon a finding that the generic claims linking them are allowable.

Further, Applicants submit that for claim 32 reciting a Markush group of species that may serve as a positive control, the members of the Markush group are sufficiently few in number and so closely related that a search and examination of the entire claim can be made without serious burden. Accordingly Applicants further traverse the species election for Subgroup C on the grounds that the Examiner has improperly restricted the Markush group reciting the species (see M.P.E.P. §803.02).

No fee is believed to be due in connection with this submission. The Commissioner is hereby authorized to credit any overpayment or charge any deficiencies to Deposit Account, **No. 06-1448** (reference **RGS-006.02**). The Examiner may address any questions raised by this submission to the undersigned at 617-832-1000

Respectfully submitted,

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